

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/077,180	19-Oct-04	KARL STORZ, ET AL.	02931-P0023A

Title: SHAVING OR CUTTING INSTRUMENT

Art Unit	Paper Number
----------	--------------

Correspondence Address:

WESLEY W. WHITMYER JR.
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD, CT. 06905

PATENT & TRADEMARK OFFICE
MAILED

FEB 10 2005

LICENSING & REVIEW

**Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Wesley W. Whitmyer
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619

In re: Storz et al : DECISION ON REQUEST
Serial No.: 09/077,180 : UNDER 37 CFR 5.25
Filing date: July 16, 1998
Docket No: 02931-P0023A

Title: SHAVING OR CUTTING INSTRUMENT

This is a decision on the petition filed on October 19, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied since the requirements of 37 CFR 5.25 (3)(ii-iii) have not been met.

Specifically, the petition is denied for the following reasons;

1. There is no convincing evidence that the patent application was filed abroad through error and without deceptive intent. Sufficient evidence should include statements by those who had knowledge and made the actual decision to file abroad without first securing a foreign filing license. In the instant case, the statement(S) should be by the person or persons of Storz Endoscope GmBH. Further, the statements should reference not only the proscribed filing error but should also document what, if anything, is currently done to rectify the docketing of similar proscribed filings.
2. The circumstances surrounding discovery of the proscribed filing needs clarification. Specifically, to satisfy the diligence requirement, there needs to be more clarification on when and how the proscribed filings were discovered.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Ian J. Lobo
Patent Examiner
(703) 306-4161